REMARKS

I. Status of the Claims

Claims 1-20 are currently pending in the Application. Claims 1 and 12 are in independent format.

The present Response is intended to be fully responsive to the rejections raised by the Examiner and is believed to place the application in condition for allowance. Further, the Applicant does not concede any of the Examiner's comments not particularly addressed. Favorable reconsideration and allowance of the application is respectfully requested.

II. Responses to Section 103(a) Rejections

The Examiner rejected Claims 1-9, 11-17, 19, and 20 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,798,385 granted to Joyce et al. ("Joyce") in view of U.S. Patent No. 6,970,548 granted to Pines et al. ("Pines"). In order to establish a *prima facie* case of obviousness over a combination of references, the combination must teach or suggest all of the claim limitations. M.P.E.P. § 2143; *In re Royka*, 490 F.2d 981 (CCPA 1974). In this case, the combination of Joyce and Pines does not teach or suggest all of the limitations of either independent claim 1 or 12. Accordingly, the combination also fails to teach or suggest all of the limitations of any of dependent claims 2-11 and 13-20.

At a minimum, the combination of Joyce and Pines fails to teach or suggest "querying a set of data to uncover at least one data-reference that the set of data correlates with . . . one or more capabilities of the device," as claimed by Applicant.

In setting forth the obviousness rejection, the Examiner admitted that "Joyce does not specifically disclose device capability information, determining one or more capabilities of the

device, and the data set correlates with the one or more capabilities of the device." Office Action, p. 3. Even taking the Examiner's assertion that Joyce discloses "querying [a] set of data to uncover at least one data-reference that the set of data correlates with the *current location of [a] device*" to be true (an assertion that Applicant does not concede), Joyce fails to disclose the feature of "querying a set of data to uncover at least one data-reference that the set of data correlates with ... *one or more capabilities of the device,*" as claimed by Applicant.

To make up for the deficiency in Joyce, the Examiner alleged that Pines "teaches device capability information, determining one or more capabilities of the device, and the data set correlates with the one or more capabilities of the device (see column 26, lines 31-53, see 'capabilities,' 'voice format' and 'text format')." Office Action, p. 3. The Examiner further asserted that:

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Pines into the system of Joyce in order to provide a system and method which provides wireless directory and other information services (see Joyce, column 1, lines 14-18).

Office Action, p. 3. Applicant respectfully submits that the Examiner improperly applies Pine's reference to "device capabilities" by not pointing to any disclosure in Pines that teaches or suggests "querying the set of data to uncover at least one data reference . . . that the data set correlates with the one or more capabilities of the device." Applicant's claimed embodiments include the recitation that "querying the set of data" uncovers a data reference that the data set correlates with *both* (i) the current location of the device *and* (ii) one or more capabilities of the device. Applicant therefore submits that Pines fails to make up for the admitted deficiency in Joyce.

Unlike Applicant's claimed embodiments, Pines does not query a set of data to uncover at least one data reference that the data set correlates with device capability information.

Generally, Pines discloses a communication assistance system that comprises a call center that can receive calls from a plurality of callers (e.g., requestors) and route those calls to an operator terminal and a first database. *See, e.g.*, Pines, Abstract. As part of the call routing in Pines, the Pines system "checks the Pre-announcement field 59 of Call Completion Data Packet 50 which indicates whether or not the subscriber of the Wireless Adapter 6 wishes a calling party to be 'pre-announced.'" Pines, col. 26, lines 14-17. Pines defines the "Call Completion Data Packet 50" as including an origination phone number field, wireless apparatus identification number field, closing prompt code field, and pre-announcement code field. *See* Pines, Fig. 9; col. 21, lines 4-17. According to Pines, the "pre-announcement" can be a requestor's name and "provides an opportunity to accept or reject the inbound call." Pines, col. 26, lines 19-20, 40.

In the embodiment of Pines cited by the Examiner, the Pines system "consults the Pre-announcement field 59 of Call Completion Data Packet 50, to determine the method of transmitting the pre-announcement." Pines, col. 26, lines 31-33. Pines then states that the "pre-announcement can be either in text or voice format" and "[u]sing the fields in Call Completion Data Packet 50, System 2 determines what format is available based on the carrier and device capabilities of Wireless Adaptor 6." Pines, col. 26, lines 33-37. The system in Pines then either sends the pre-announcement in "voice format," or converts the requestor's name (pre-announcement) to a "text message" and sends the pre-announcement using "[t]ext messaging." Pines, col. 26, lines 41-53.

Thus, at best, Pines appears to teach a system that determines whether to transmit a pre-announced name as a voice or text message, based on whether the receiving device can accept text messages. Pines, however, does not teach or suggest the presently claimed function of

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"querying a set of data to uncover at least one data-reference that the set of data correlates with . . . the one or more capabilities of the device," as recited in independent claims 1 and 12.

Even if Pines is taken to teach device capability information and determining one or more capabilities of a device (an assertion that Applicant does not concede), at best, Pines discloses "consult[ing]" a "Pre-announcement field 59" of a "Call Completion Data Packet 50," not querying a set of data for the purported device capabilities. Moreover, Pines fails to teach or suggest querying a set of data to uncover at least one data-reference. Instead, Pines is directed to a "method of transmitting [a] pre-announcement." *See, e.g.,* Pines, col. 26, lines 32-33. As disclosed in Pines, the "pre-announcement" is ___not___ uncovered via a query but rather is ___recorded___ by a person placing a call at the time of the call. *See, e.g., id.* col. 26, lines 31-42. Applicant therefore submits that independent claims 1 and 12 are allowable.

Applicant respectfully submits that the Examiner has not established the requisite *prima facie* case of obviousness of Applicant's independent claims 1 and 12, for the reasons discussed above. Without addressing the merits of the Examiner's statements regarding the pending dependent claims 2-11 and 13-20, which are not conceded, Applicant points out that these claims depend from and include all of the limitations of claims 1 and 12. Therefore, Applicant's dependent claims distinguish over the cited references for the same reasons discussed above with regard to independent claims 1 and 12. Applicant respectfully submits that the Examiner has not established the requisite *prima facie* case of obviousness of the pending dependent claims.

CONCLUSION

In light of the above amendments and remarks, Applicant submits that the present application is in condition for allowance and respectfully requests notice to this effect. The

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Examiner is requested to contact Applicant's representative below at (312) 913-0001 if any questions arise or if he may be of assistance to the Examiner.

Respectfully submitted,

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